LIBRARY
SUPREME COURT, U. S.
APR 29 1974
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-1624

ANDREA DUMON, INC. and BERNARD MALITS,

Petitioners,

vs.

CLAIROL, INCORPORATED,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE APPELLATE COURT OF ILLINOIS, FIRST DISTRICT

ESTHER O. KEGAN
GLENN E. KLEPAC
KEGAN, KEGAN & BERKMAN
79 W. Monroe Street, Suite 1320
Chicago, Illinois 60603

DAVID CHAIMOVITZ
33 N. LaSalle Street, Suite 2021
Chicago, Illinois 60602

Attorneys for Petitioners

Midwest Law Printing Co., Chicago 60601, Financial 6-3988

TABLE OF CONTENTS

PAGE

INTRODUCTION 1

OPINIONS BELOW 2

JURISDICTION 2

THE INSTANT CASE PRESENTS SUBSTANTIAL FEDERAL QUESTIONS 3

STATEMENT OF THE CASE 3

PHOTOGRAPH OF CONTAINERS 7

REASONS FOR GRANTING THE WRIT:

I.

The State Court Unduly Expanded The State Law of Unfair Competition to Be Anticompetitive 8

II.

The Court Below Erroneously Inferred Protectability of Package Graphics By Evidence of Defendant's Copying Part of Such Graphics 11

III.

The Assessment of Attorney's Fees Against Defendants Deprived Them of Due Process 12

CONCLUSION 14

Table Of Authorities

Cases

Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 84 S.Ct. 779, 11 L.Ed. 2d 669, 140 USPQ 528 (1964) 9, 10

Fleischman Distilling Corporation v. Maier Brewing Co., 386 U.S. 714, 18 L.Ed. 2d 475, 87 S.Ct. 1404, 153 USPQ 432 (1967) 13

Mr. Gasket Co. v. Travis, 299 N.E.2d 906, (Ohio Ct. App. 1973) 10, 11

Ralston Purina Co. v. Thomas J. Lipton, Inc., 341 F. Supp. 129 (S.D.N.Y. 1972) 11

Sears Roebuck & Co. v. Stiffel Co., 376 U.S. 224, 84 S.Ct. 784, 11 L.Ed. 2d 661, 140 USPQ 524 (1964) 9, 10

Miscellaneous

Federal Copyright Law, 17 U.S.C. §5(f), §10 12

Uniform Deceptive Trade Practices Act, Ill. Rev. Stat. (1967), ch. 121, sec. 311 et seq. 12, 13

Fourteenth Amendment to the United States Constitution 14

IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No.

ANDREA DUMON, INC. and BERNARD MALITS,

Petitioners,

vs.

CLAIROL, INCORPORATED,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE APPELLATE COURT OF ILLINOIS, FIRST DISTRICT

To the Justices of the Supreme Court of the United States:

Petitioners, Andrea Dumon, Inc. and Bernard Malits, respectfully pray that a writ of certiorari issue to review a judgment of the Appellate Court of Illinois, First District, affirming the decision of the Circuit Court of Cook County, Illinois, which enjoined petitioners from using graphics or "trade dress" on bottles of hydrogen peroxide similar to the graphics on respondent-plaintiff's bottle, and which awarded plaintiff attorney's fees of $20,616.43.

OPINIONS BELOW.

The opinion of the Circuit Court was unofficially reported in the United States Patent Quarterly at 163 USPQ 245, and copies of the Circuit Court's Memorandum dated July 10, 1969; Decree dated July 31, 1969; and Supplemental Memorandum of June 25, 1970 are reproduced in the Appendix, pp. 1a-13a. The Circuit Court's opinion was affirmed by the Appellate Court on June 12, 1973 and a rehearing was denied on October 31, 1973. The Appellate Court's opinion was reported officially at 14 Ill. App. 3d 641, 303 N.E. 2d 177 and unofficially at 179 USPQ 119. A copy of the Appellate Court's opinion is reproduced in the Appendix at pp. 14a-26a.

Petitioners filed a petition for leave to appeal the Appellate Court's decision in the Supreme Court of Illinois, and said petition was denied on January 30, 1974. A copy of said notice of denial is included in the Appendix at page 26a.

The judgment of the state court here sought to be reviewed has been determined by the highest court in which a decision could be had and is final.

JURISDICTION.

On January 30, 1974, the judgment of the Supreme Court of Illinois was entered. Jurisdiction of this Court to review the state court's judgment rests on 28 U.S.C. §1257(3) and Rule 19.1(a) of the Rules of the United States Supreme Court.

THE INSTANT CASE PRESENTS SUBSTANTIAL FEDERAL QUESTIONS.

Contrary to the principles of the *Sears* and *Compco* cases, the state court granted the plaintiff exclusive rights to certain uncopyrighted graphics on a bottle, such as color of type and two horizontal bar lines, notwithstanding that plaintiff did not show any identification of said graphics by the public so as to establish "secondary meaning". The court assumed plaintiff made sufficient proof of "secondary meaning" of its trade dress by showing that defendant copied certain insignificant portions of that trade dress.

Further defendants were deprived of due process when the court awarded plaintiff attorney's fees under a state Deceptive Trade Practices Act in the absence of any evidence in the record that defendant had wilfully engaged in a deceptive trade practice.

The federal questions sought to be reviewed were properly raised in the state courts below.

The state court decision below here sought to be reviewed does not rest upon a state ground which independently and adequately supports the judgment in question.

STATEMENT OF THE CASE.

This is an action in unfair competition arising out of defendant's sale of bottled hydrogen peroxide. Prior to the end of the trial but with no amendment of the pleadings based on common law, plaintiff advised the court it was relying on the Uniform Deceptive Trade Practices

Act passed in Illinois in 1965 (Ill. Rev. Stat. 1967, Ch. 121½, Sec. 311 et seq).

Petitioner-defendant Andrea Dumon, Inc. is a manufacturer of beauty care products; petitioner Bernard Malits is President of Andrea Dumon, Inc. Hereinafter "defendant" will refer to the corporate defendant.

Respondent-plaintiff, Clairol, Incorporated, is a well-known marketer of cosmetic products, especially products for coloring and treating hair all sold under its trademark CLAIROL. Plaintiff sells its products at retail and to beauty shops.

In May, 1966, defendant introduced its peroxide developer to be used in conjunction with hair dye. The front label copy of defendant's bottles displayed its trademarks ANDREA DUMON and the design of the Golden Gate bridge; also the name of the product "White Creamed Peroxide Developer", the net contents, and two horizontal straight bar lines. The color of type alternated by line, black and mustard color. The front copy of this container is shown on the photograph on page 7. The back copy displayed the directions for use and the complete name and address of the defendant.

In June, 1966, plaintiff filed suit against defendant charging common law unfair competition, alleging that the graphics or "trade dress" on defendant's bottle so closely simulated the graphics of plaintiff's "Pure White Creme Developer" that consumers would mistakenly purchase defendant's product in the belief it was plaintiff's.

The products of both parties, being a form of hydrogen peroxide, are unpatented and sold in competition with each other. By their chemical composition this product is opaque white in color. Plaintiff's product was introduced

in 1960 and was packaged in transparent stock bottles and caps. The front panel of plaintiff's product displayed plaintiff's trademarks CLAIROL and its crown design. Below this was an ochre colored broken line with a peak pointing to the CLAIROL trademark, followed by plaintiff's description of the product "Pure White Creme Developer" and a horizontal straight line bar, in alternating color of type, black and ochre. A photograph of plaintiff's bottle is reprinted on page 7.

During the course of the trial, the plaintiff limited its objection to the defendant's use of the color mustard and the two line bars. After July, 1966 defendant modified the bottles for its White Creamed Peroxide Developer so that the printed word portions were printed only in black color and the two bar lines were omitted. No objection was taken by plaintiff to the trade dress of this single color bottle. Defendant's total sales of the botttles with two colors of type were $175.00.

At the trial, plaintiff's only witness in support of its claim that the bottle graphics were distinctive was one of its Vice-Presidents who testified that plaintiff's Pure White Creme Developer was the leading product of its kind with sales exceeding $15,000,000. Plaintiff never advertised its Creme Developer and no consumer testimony or other evidence was introduced to show that the consuming public ever identified the product by the alleged graphics. Defendant's witness testified consumers asked for the plaintiff's product by the mark CLAIROL.

The evidence disclosed that defendant's employee knew of the Clairol bottle, and defendant's original label sketch showed similarities to plaintiff's bottle, with the upper broken line and peak design pointing to the ANDREA

DUMON trademark. Prior to the final design of defendant's bottle graphics, this peak line was changed to a solid horizontal bar line as shown in the annexed photograph.

The trial court held for the Plaintiff, finding:

> "Uncontradicted proof that the defendants copied the design of plaintiff's bottles and trade dress established their possession of a secondary meaning. . . . The inference will arise that what is copied has distinctive quality, and that it has acquired a secondary meaning which need not be shown by independent evidence." App. p. 10a.

In the Decree, subsequently entered, the defendants were permanently enjoined from using the trade dress described in the Court's Memorandum. The Decree further provided

> "That defendants having been found to have wilfully engaged in a deceptive trade practice in that they wilfully simulated plaintiff's trade dress, that plaintiff's costs and attorney's fees be assessed against said defendant and that a hearing be held to determine the amount of said costs and fees." App. p. 12a.

On June 25, 1970 the Court entered a Supplemental Memorandum overruling defendant's objections to the findings of fact and to the award of attorney's fees. (App. p. 13a)

An appeal from this decision was taken to the Appellate Court of Illinois, which affirmed the trial court, concluding

> "Proof of copying, together with visual comparisons showing similarity in use and appearance between Andrea Dumon's and Clairol's products, is sufficient to establish that the trade dress employed by the defendants is likely to deceive the public and cause public confusion as to source." App. p. 20a.

The Illinois Supreme Court refused to grant an appeal from this decision. (App. p. 26a)

CLAIROL
PURE WHITE
CREME
DEVELOPER
THE CREME LOTION THAT
REPLACES ORDINARY PEROXIDE
FOR BETTER HAIR CONDITION.
Contents One Pint
ANDREA DUMON
WHITE
CREAMED PEROXIDE
DEVELOPER
THE CREAMED PEROXIDE THAT
REPLACES ORDINARY PEROXIDE
FOR BETTER HAIR CONDITIONING—
MAKES WORKING WITH ALL
PERMANENT HAIR COLOR
AND LIGHTENERS EASIER.
NET CONTENTS
13½ FL.Oz.

REASONS FOR GRANTING THE WRIT.

I.

THE STATE COURT UNDULY EXPANDED THE STATE LAW OF UNFAIR COMPETITION TO BE ANTICOMPETITIVE.

Under the guise of protecting against common law unfair competition or state statutory Deceptive Trade Practices, the decision below granted plaintiff greater rights of exclusivity than if its package dress had been protected by Federal patent or copyright. The offense of the defendant was that a sketch of the graphics similar to the plaintiff's was used to make up defendant's copy. Differing were the trademarks, designs of crown or bridge and the name of the product; the line under the Clairol mark was broken to peak up whereas the defendant had a straight line bar. The similarity was that of color of type on three of these lines, a mustard or ochre color alternated by black. Plaintiff had no objection to the modified bottle dress adopted by defendant which retained all the design and word elements except that two straight bar lines were omitted and the ochre color type was changed to black. We are here confronted with a situation where a court enjoined the use by a competitor of two lines and a certain color of type on a stock bottle.

The Federal grants of monopoly are limited in time and subject to their own limitations in proving infringement. The decision to be reviewed enjoined the petitioner from using color of type, two bar lines, common packaging elements—giving to the plaintiff an exclusivity which plain-

tiff could not get under any patent, trademark or copyright law.

Justice Black in the *Sears* case ruled that a state's unfair competition law may not impose liability for, or prohibit, the copying of an article which is not protected by a federal patent or copyright. *Sears Roebuck & Co.* v. *Stiffel Co.* (1964) 376 U.S. 225, 84 S.Ct. 784, 11 L.Ed.2d 661, 140 USPQ 524.[1] This court stated:

> "To allow a State by use of its law of unfair competition to prevent the copying of an article which represents too slight an advance to be patented would be to permit the state to block off from the public something which the federal law has said belongs to the public." 376 U.S. at p. 231.

The decision here sought to be reviewed would limit the applicability of the *Sears* doctrine only to the physical properties of an article and thus give monopoly rights to simple graphic elements of a bottle design. For example, the Appellate Court held:

> "*Sears* and *Compco* involved the copying of articles or products, and not the simulation of trade dress." App. p. 23a.

By discarding the principles of the *Sears* case in the instant situation, the court below set up its own rules of competition. The court below asserted that "proof of copying" in and of itself is sufficient to establish "public confusion as to source"; this approach is in contrast to the statement by the Supreme Court in the *Sears* case that packaging of goods must be "distinctive" if limita-

---

[1] The companion *Compco* case is *Compco Corp.* v. *Day-Brite Lighting, Inc.*, (1964) 376 U.S. 234, 84 S.Ct. 779, 11 L.Ed.2d 669, 140 USPQ 528.

tions are to be likely to mislead purchasers as to the source of the goods. In the instant case, the plaintiff's claim of distinctiveness can be negated by reference to Photo B, which shows the graphic elements of plaintiff's bottle to be descriptive or common packaging elements.

At trial, plaintiff was unable to demonstrate that members of the consuming public had come to associate the trade dress of the Clairol developer with plaintiff. Plaintiff, a big advertiser of some of its products, had never advertised or promoted its peroxide developer package to the public so as to form a conscious connection in the minds of the public between its trade dress and Clairol. Plaintiff did not bring forth *any* customer testimony or consumer surveys demonstrating identification of its trade dress with itself. In short, the record is totally barren of any direct evidence of "secondary meaning" for the label of the CLAIROL Pure White Creme Developer.

Since 1964 the *Sears* and *Compco* cases have been cited, explained, distinguished and variously interpreted by numerous courts, some with inconsistent effects. During this past year alone, conflicting interpretations as to the Sears doctrine have been reported by the instant case and the case of *Mr. Gasket Co.* v. *Travis,* 299 N.E.2d 906, 911 (Ohio Ct. App. 1973). This Honorable Court should grant certiorari. Businessmen and the courts need amplified guidelines as to the proper roles of federal monopolies, state trade regulations and the public domain.

II.

THE COURT BELOW ERRONEOUSLY INFERRED PROTECTABILITY OF PACKAGE GRAPHICS BY EVIDENCE OF DEFENDANT'S COPYING PART OF SUCH GRAPHICS.

In order to prevail in its action to enjoin use of the trade dress on ANDREA DUMON "White Creamed Peroxide Developer", on a theory of unfair competition, plaintiff had the burden of proving that consumers of the ANDREA DUMON developer would purchase it as a result of confusion or mistake with CLAIROL "Pure White Creme Developer". In order to meet its burden of proof Plaintiff was required to demonstrate that the trade dress of the CLAIROL developer had acquired association in the minds of the consuming public with a single source prior to June, 1966. Such association is commonly known as "secondary meaning."[2] As one court has observed recently, ". . . if there is no secondary meaning, no consumer cares about the source and the likelihood of confusion, if any, is neutralized by apathy." *Mr. Gasket Co.* v. *Travis,* 299 N.E. 2d 906, 913 (Ohio Ct. App. 1973).

In lieu of proof of any consumer identification with plaintiff's bottles, plaintiff relied upon evidence that defendant referred to plaintiff's bottle in preparing its rough-drawn label sketch. Before any product was sold, the top broken peak shown on plaintiff's bottle was

---

(2) "The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods, but the source of those goods. To establish secondary meaning, it must be shown that the *primary* significance of the term in the minds of the consuming public is not the product but the producer." *Ralston Purina Co.* v. *Thomas J. Lipton, Inc.,* 341 F.Supp. 129, 133 (S.D.N.Y. 1972).

changed to a solid horizontal bar line. Both lower courts held that by defendant's use of alternating two colors and two bar lines on its bottle defendant "copied" its trade dress from plaintiff, and that such copying was sufficient to establish secondary meaning for the CLAIROL label.

Defendants submit that it was error for the lower courts to draw an inference of secondary meaning for the CLAIROL label from their finding that portions of the ANDREA DUMON label were copied from the CLAIROL label. Since the CLAIROL label bore no notice of copyright, plaintiff was not eligible for the protection against copying that is available for labels under Federal Copyright Law.[3]

Plaintiff has no right to prohibit defendant from displaying its label copy in two colors and in using two horizontal bar lines. The court erred in enjoining such use and certiorari is necessary to give defendant and the public relief from such unwarranted extensions of monopoly rights.

III.

THE ASSESSMENT OF ATTORNEY'S FEES AGAINST DEFENDANTS DEPRIVED THEM OF DUE PROCESS.

The complaint was founded on a charge of common law unfair competition—attorneys' fees would not be assessable under such complaint. During the trial, without amending the Complaint and long after defendant had discontinued sale of the alleged offending bottle, plaintiff charged defendant with violation of *Illinois' Uniform De-*

---

[3] 17 U.S.C. §5(f)
17 U.S.C. §10

ceptive Trade Practices Act (Ill. Rev. Stat. (1967) ch. 121, sec. 311 et seq.) Such act provided: (§313)

> "Costs or attorneys' fees or both may be assessed against a defendant only if the court finds that he has wilfully engaged in a deceptive trade practice."

The trial judge in its Memorandum setting forth its Findings made no reference to any alleged wilfulness of defendant's act. The subsequent Decree for the first time made reference to defendant's acts as "wilful." Attorneys' fees in the sum of $20,616.43 were awarded to plaintiff--even though defendant's alleged unfair competition was its use of two colors of type and two horizontal line bars on its bottles for less than a few months, and defendant's sales of the offending bottle totaled $175.

The plaintiff made no objection, and specifically approved in court, the trade dress of defendant's bottle sold after the first few months. Defendants asserted their right to accurately identify their product and to use such common design elements as mustard color type or lines dividing the label copy. This case presented for the first time in Illinois the issues of the Illinois Deceptive Trade Practices Act, thus raising important issues of public policy. For this assertion of legal right the court penalized the defendant by imposing attorneys' fees amounting to a penalty of 120 times defendant's gross sales.

This court held in *Fleischmann Distilling Corporation* v. *Maier Brewing Co.*, 386 U.S. 714, 18 L.Ed. 2d 475, 87 S.Ct. 1404, 153 USPQ 432 (1967) that attorneys' fees cannot be awarded against a deliberate trademark infringer on the basis that under our American system of jurisprudence attorney's fees should be awarded only

pursuant to express provision of a statute. It would therefore be reasonable that even when a statute authorizes attorneys' fees, such award should be granted only when defendant is found guilty of unusual wilful disregard of plaintiff's rights. Everything in the record here indicates that defendants took careful steps to prominently identify its product and to distinguish its product from plaintiff's. Under established principles, defendant's conduct did not constitute a "wilful" deceptive trade practice.

Under the circumstances of this case, the award of attorney's fees and costs to plaintiff deprived defendant of due process as guaranteed by the Fourteenth Amendment.

CONCLUSION.

This case presents important issues of public policy—should competition in the use of common packaging graphics be permitted or prohibited? The ambit of the competitive standards first enunciated in the *Sears* and *Compco* cases needs clarification and the instant case affords this Honorable Court such an opportunity.

WHEREFORE, petitioners pray that this Court's Writ of Certiorari issue and that the judgment below be reversed.

Respectfully submitted,

ESTHER O. KEGAN
GLENN E. KLEPAC
KEGAN, KEGAN & BERKMAN
79 W. Monroe Street, Suite 1320
Chicago, Illinois 60603

DAVID CHAIMOVITZ
33 N. LaSalle Street, Suite 2021
Chicago, Illinois 60602

Attorneys for Petitioners

APPENDIX

STATE OF ILLINOIS
COUNTY OF COOK—ss.

IN THE CIRCUIT COURT OF COOK COUNTY,
ILLINOIS, COUNTY DEPARTMENT,
CHANCERY DIVISION

CLAIROL INCORPORATED, Plaintiff, v. ANDREA DUMON, INC., and BERNARD MALITS, Defendants.	In Chancery No. 66 CH 2692

MEMORANDUM

(Filed July 10 1969)

This is a suit by Clairol Incorporated against Andrea Dumon, Inc. and Bernard Malits seeking relief in equity and damages at law for defendants' alleged simulation and imitation of what plaintiff says is a distinctive trade dress of its product "Pure White Creme Developer."

The suit has been heard on complaint and answer. Evidence consisting of testimony of witnesses and exhibits have been offered and received. After the trial, the parties filed briefs on the legal questions raised; each side urged findings in its favor. This memorandum contains the court's findings and conclusions.

I.

Findings of Fact

Clairol Incorporated is engaged in the manufacture and sale of cosmetic products. Its trade name is "Clairol" through which it has established a large and successful business, particularly in the sale of products for the

coloring and treatment of human hair. Its most important product is the "Miss Clairol" line of permanent hair dyes in a variety of shades. These dyes are coal tar products used by professional hairdressers in beauty salons, and at home by members of the general public.

In 1958, because of dissatisfaction with the quality of existing peroxide products, Clairol began marketing a product it called "Pure White Creme Developer." Originally, distribution of this product was limited to the salon trade and sold in 16 ounce bottles. Two years later the same product was introduced in a 4 ounce bottle for sale at retail. Clairol marketing policy involves contracts with distributors who agree to keep the products for the salon trade separate from the products sold to the general public. Despite this policy, there are occasions when products for the salon trade are sold to members of the general public.

The 16 ounce bottle in which Clairol marketed its "Pure White Creme Developer" was cylindrical with a height of approximately 7 and ½ inches, and the top of the cap made of clear glass. When filled, the white color of the bottle's content furnished a background which emphasized the graphic elements printed on the outside of the bottle. Below the shoulder of the bottle, Clairol put a crown design it uses on the package and/or dress of many of its products. The word "Clairol" in block letters appear approximately 3/16th of an inch in size. Below the name "Clairol" was a bar extending horizontally around 60% of the circumference of the bottle. Beneath the horizontal bar were the words "Pure White Creme Developer" in block print, approximately 5/16th of an inch in height. Part of the bottle format were descriptive words concerning plaintiff's product. Alternating mustard gold and black coloring sequence was used for each design, the crown design being in gold, the name "Clairol" being in black, the peaked bar in gold with words "Pure White" in black, and the word "Creme" in gold. On the rear side of the bottle appear advertising copy and direction for use of Clairol's product.

Clairol's smaller 4 ounce bottle contained the same graphic display as was put on the 16 ounce, the letters being comparatively smaller to conform to the size of the bottle and its carton.

Since marketing its products in the two bottle sizes, Clairol has enjoyed considerable success. From 1960 until 1965 when defendants' product was prepared for marketing, Clairol sold more than 15 million dollars of its "Pure White Creme Developer." For each of its 16 ounce bottle, Clairol sold four of the smaller size.

From 1959 to 1961 the defendant Bernard Malits was regional sales manager for Clairol with responsibility for sales to the retail trade in Illinois and surrounding states. After leaving plaintiff's employ, Mr. Malits began business through a corporation, Malits Drug Company. This company came to operate a chain of 10 retail stores in Chicago selling drugs, cosmetics, and related items. Until the instant suit was filed, Malits Company did business under a trade name, "Golden Gate."

In 1965, Mr. Malits organized Andrea Dumon, Inc. as an Illinois corporation, with headquarters in the city of Chicago. Through retail stores in different parts of the country, it began marketing cosmetic products designed for the bath and shampoos. Mr. Malits was and still is the president of Andrea Dumon; and he owns most of its stock.

Sometime late in 1965, Andrea Dumon, Inc. began plans to bring out a creme peroxide product. In determining the design of the trade dress for this product, Mr. Zabell, Andrea Dumon's sales manager, procured a number of sample bottles then in use, including the bottle for plaintiff Clairol's "Pure White Creme Developer." Plaintiff's trade dress on the bottle was different in arrangement and decoration from the trade dress and package of other products marketed in plastic containers or glass bottles. Mr. Zavell prepared a rough drawn sketch of what was to be defendants' bottle and trade dress. On behalf of Andrea Dumon, Inc. it was decided that a stock glass

bottle of approximately 16 ounce capacity was to be used. The rough drawn sketch was then submitted by Mr. Zavell to an artist employed by the company which was to supply the bottles for defendants' peroxide product.

A visual examination of the sketch discloses that it was copied directly from Clairol's 16 ounce bottle. The sketch closely follows the principal features of Clairol's trade dress, the sequence of design elements, the size, color and their special relationship to each other. On the sketch are handwritten notations which show instructions that the artist follow the spacing of the bars and other elements of plaintiff's 16 ounce bottle; so that the end product would correspond to the principal features of Clairol's package. Together with this sketch, the artist was given instructions as to the ultimate product he was to complete. Except for having seen a picture of Clairol's trade dress in a magazine, the artist was not familiar with Clairol's product "Pure White Creme Developer." From the sketch, and after some changes, the artist completed his art work and designed the bottle which is the subject of this suit.

Defendants' bottle, as produced from their instructions, was also of stock kind, cylindrical, and approximately 16 ounce in size, of glass with the same physical configuration as plaintiff's bottle. It differed in some detail at the shoulder; and at the cap, it was about twice the size of plaintiff's. At the top was an artistic drawing of the Golden Gate Bridge, a design reproduced in size approximately that of Clairol's crown device. Below this design, in plain block letters, appeared the words "Andrea Dumon" in letters smaller than the Clairol name on plaintiff's 16 ounce bottle. With the exception of details of little importance, defendants' bottle was similar to that of plaintiff's 16 ounce and 4 ounce bottles.

Defendants' bottles also used mustard, golden black colors on the trade dress on each of the bottles. The difference being that as to their small bottle, defendants used a 5 and ½ ounce in contrast with plaintiff's 4 ounce bottle.

The trade dress of bottles and packages used by the parties play a role in the sale of their products. The trade dress has an influence in the recognizability of the product and its impression, depending on the distance from which the prospective purchaser first sees the product, and the way in which the product is displayed on shelves. If purchase of products like those produced by the parties is made from self-service shelves, prospective purchasers first receive impressions concerning the desired article from a distance, approximately twelve to about twenty feet. Plaintiff, in the design of its trade dress, and in the production of its product, "Pure White Creme Developer," has taken these circumstances into account in the design of its package and trade dress.

Hair dye developers are relative low priced items. Their purchase is not an impulsive one. On the other hand, purchase of items such as those manufactured by Clairol in its production of "Pure White Creme Developer" is not an unthinking act nor one that involves circumspection. Their purchase is not whimsical; but is to fulfill a specific need, though the purchase occurs at the same time as the hair dye itself is bought. In the purchase of products like Clairol's "Pure White Creme Developer," small similarities in trade dress design and packaging can influence the selection a purchaser makes as between products having nearly similar trade dress or package. Taking into account the product, the purchaser who will buy it, and the need that the product such as plaintiff's "Pure White Creme Developer" fills, similarities in trade dress in packaging are factors that influence their selection. If there is a similarity in trade dress and package, a greater care in the inspection of the label to ascertain the source of the product is required.

Plaintiff's 16 ounce bottle is produced, packaged and distributed by plaintiff for use in beauty salons, or what is called the professional trade. Its appearance comes to the attention of the general public by being seen in salon by patrons who in turn are potential retail purchasers of plaintiff's product. Plaintiff's 4 ounce bottle

is sold in cartons. Defendants' comparable size is not cartoned. Plaintiff's 4 ounce bottle is subject to a use by the purchaser that requires its being taken from its carton. When plaintiff's 4 ounce bottle becomes uncartoned, the similarity between that bottle and defendants' comparable bottle becomes significant. The significance of similarities in the design of the two bottles is that alertness in a prospective purchaser of defendants' bottle is required in order that he or she distinguish between the two when faced with the choice of buying defendants' comparable product.

The trade dress that Clairol has adopted for the sale of its 16 ounce and 4 ounce bottles of "Pure White Creme Developer" are distinctive in appearance, and they constitute the means by which prospective purchasers identify and select plaintiff's products when displayed for sale. The trade dress design utilized by plaintiff in both bottle sizes is capable of leaving a memorable impression on prospective buyers and distinguish plaintiff's product substantially from other competitive products. Circumtsances surrounding purchase of products of the kind that plaintiff has packaged in its two sized bottles are factors in determining whether consumer confusion is likely to occur. When competitive products are sold in a trade dress that possesses similar decorative features there is likelihood of consumer confusion. This likelihood appears from the evidence in this case when a comparison is made between Clairol's two sized bottles and those of the defendants. When placed together, plaintiff's bottles show a similarity that is not distinguished from defendants until careful attention is paid to the differences that exist in the trade dress adopted by plaintiff and that adopted by the defendants for their similar product. When placed near each other, the trade dress used by plaintiff in its bottles show similarity with the trade dress used by defendants. If plaintiff's product with its trade dress and defendants' with theirs are placed together, the differences in appearances are emphasized, allowing for comparisons to be made. But in this situation, atten-

tive effort by a prospective purchaser is necessary. On the other hand, if no opportunity of thought is available by which plaintiff's product in its trade dress is compared with the defendant's product in their trade dress, a prospective purchaser who is called on to distinguish defendant's product from plaintiff's from recollection of the Clairol trade dress, is likely to be governed by similarities of what is perceived to what is recalled.

The fact that both parties to this litigation are engaged in marketing their respective products nation-wide in retail stores which they do not control, has some significance on the possibility of customer confusion. Stores which the parties do not control can and on occasion do display products of the defendants on the same display shelf with those produced, packaged, and marketed by Clairol. This fact increases the possibility of customer confusion.

Defendants have not controverted plaintiff's proof that they copied plaintiff's trade dress. Plaintiff's evidence in this regard is relevant to the issue concerning the distinctiveness of plaintiff's package and the trade dress it has selected for its product.

Defendants marketed other hair and bath products. A comparison of the trade dress generally used by defendants shows they differ from the trade dress they used in the sale of their peroxide developer.

Early in 1966, defendants began marketing their peroxide developer in bottles containing the graphic design produced from the sketch prepared by Mr. Zevall, and from instructions defendants gave the artist selected by them. Defendants developed a product which became identified through the trade dress thus utilized. Sales were made through the Golden Gate retail stores owned by the defendant, Mr. Malits. Evidence does not disclose with certainty the quantity of sales of the two bottles used by defendants to market their peroxide developer. With the filing of this suit, defendants discontinued sales of both bottles. Since this suit was filed, defendants have sold their product, both the 15 and ½ ounce and the 5

and ½ ounce versions, in a revised bottle design to which the plaintiff does not object. Defendants maintain their right to resume use of the trade dress in issue; and they have resisted plaintiff's present suit.

II.

Conclusions of law

Although in its complaint plaintiff does not affirmatively rely on the Uniform Deceptive Trade Practices Act which became effective January 1, 1966 (ch. 121½ secs. 311-317), the provisions of that statute control this cause of action. It is not necessary that pleadings make specific reference to any statute, providing only that facts are alleged from which it can be ascertained what law is involved. *Chase* v. *Schultz,* 348 Ill. App. 595, 109 N.E. 2d 636 (1953).

The defendants engaged in unfair competition when, without plaintiff's consent, they commenced to sell a competitive product bottled in a way that colorably imitated and simulated the bottles which plaintiff used for its product, "Clairol Pure White Creme Developer." The bottles and trade dress plaintiff used for this product are distinctive. The test of distinctiveness is whether the thing so described has a quality "serving to distinguish; setting apart from others." Cf. *Gavin* v. *Webb,* (Tex. Cir. App.) 99 S. W. 2d 372, 378 (1936); Webster's Third New International Dictionary (1966). One court has said that "distinctive" means characteristic; having a distinct character or position; a distinguishing mark or quality. *Petition of Idaho State Federation of Labor* (AFL), 75 Idaho 367, 272 P. 2d 707, 710 (1954).

Long before enactment of the Uniform Deceptive Trade Practices Act, it was held that one who sells his product in a package unnecessarily similar to that of a prior user is an unfair competitor. *Helmet Co.* v. *Wm. Wrigley, Jr. Co.,* 245 F. 824 (6th Cir. (1917)); *W. G. Reardon Labora-*

tories v. *B & B Exterminators*, 3 F. Supp. 467 (D.C. Md. 1933). In one of this country's oldest cases on the subject, the Supreme Judicial Court of Massachusetts, speaking by Justice Holmes, held that a plaintiff-manufacturer who had used a distinctive package in the sale of his product was entitled to an injunction to restrain its appropriation, even though the defendant did not intend to deceive the public. *New Egland Awl and Needle Co.* v. *Marlboro Awl and Needle Co.*, 168 Mass. 154, 46 N.E. 386 (1897).

Copying, simulating, or adopting the trade dress or package of a prior user is a form of unfair competition. One who shows use of a trade dress or package prior to its appropriation by a defendant-competitor is entitled to relief by injunction. *H. E. Winterton Gum Co.* v. *Autosales Gum and Chocolate*, 211 F. 612 (6th Cir. 1914). Color and other markings may be elements which make up the dress of goods entitling a prior user to protection against unlawful competition in the form of simulation, copying or appropriation. *Socony-Vacuum Oil Co.* v. *Rosen*, 108 F. 2d 632 (6th Cir. 1940); *Chesebrough Mfg. Co.* v. *Old Gold Chem. Co.*, 70 F. 2d 383 (6th Cir. 1934); *Eastman Kodak Co.* v. *Royal-Pioneer Paper Box Mfg. Co.*, 197 F. Supp. 132 (E.D. Pa. 1961).

The bottles which the plaintiff used in marketing and selling its product "Clairol Pure White Creme Developer" identified the product with the Plaintiff and distinguished it from similar products made and sold by others. The trade dress as used is a valuable property right. Equity will protect the plaintiff from unlawful appropriation of its bottle design and trade dress by simulation or copying. *New England Awl and Needle Co.* v. *Marlboro Awl and Needle Co.*, 168 Mass. 154, 46 N.E. 386 (1897); *Socony-Vacuum Oil Co.* v. *Rosen*, 108 F. 2d 632 (6th Cir. 1940).

Defendants contend that plaintiff cannot recover judgment in this suit because it did not prove that the bottles and trade dress of "Clairol Pure White Creme Developer"

have acquired a secondary meaning; that is, the trade dress on plaintiff's bottles has become associated in the public mind with plaintiff as source of the product thus marketed. *Sink* v. *Snow-Craggs Corporation*, 105 F. 2d 450 (7th Cir. 1939). This contention overlooks plaintiff's unrebutted proof that the defendants copied the trade dress of plaintiff's bottles. In other words, defendants intentionally sat about appropriating the design and appearance of the bottles used by the plaintiff. Was it necessary for the plaintiff to introduce independent evidence that the trade dress of its product had acquired a secondary meaning?

Uncontradicted proof that the defendants copied the design of plaintiff's bottles and trade dress established their possession of a secondary meaning. *Audio Fidelity, Inc.* v. *High Fidelity Recordings, Inc.*, 283 F. 2d 551, 558 (9th Cir. 1960). Proof of copying, together with visual comparisons of plaintiff's with defendant's bottles showing similarity in use and appearance, is sufficient to establish that the trade dress used by defendants is likely to deceive the public and cause confusion between plaintiff's product and that of the defendants. *Audio Fidelity, Inc.* v. *High Fidelity Recordings, Inc.*, 283 F. 2d 551 (9th Cir. 1960); *Fleishmann Distilling Corp.* v. *Maier Brewing Co.*, 314 F. 2d 149 (9th Cir. 1963). In *Noma-Lites, Inc.* v. *Lawn Spray, Inc.*, 222 F. 2d 716 (2d Cir. 1955), it was held that where advertising and promotional materials were copied from those used by the plaintiff, equity will protect by injunction without preliminary showing of secondary meaning.

Defendant's reliance on *Sears, Roebuck and Co.* v. *Stiffel Co.*, 376 U.S. 225 (1964) and *Compco Corp.* v. *Day-Brite Lighting, Inc.*, 376 U.S. (1964) is misplaced. These cases involved the copying of an article, not a trade dress.

The rule to be deduced from the cases is that proof without contradiction showing that the trade dress or package of another is copied, the inference will arise that what is copied has distinctive quality; and that it has acquired a secondary meaning which need not be

shown by independent evidence. *Audio Fidelity, Inc.* v. *High Fidelity Recordings, Inc.*, 283 F. 2d 551 (9th Cir. 1960), *Fleischmann Distilling Corp.* v. *Maier Brewing Co.*, 314 F. 2d 149 (9th Cir. 1963); Note, Developments in the Law-Competitive Torts, 77 Harv. L. Rev. 888, 911-918 (1964). Plaintiff, by proving that defendants copied the bottle and trade dress it used in marketing "Clairol Pure White Creme Developer" proved possession of a secondary meaning so valuable that it motivated defendants in appropriating what was plaintiff's property.

Similarities between the trade dress of plaintiff's product and that copied and adopted by the defendants for theirs show there is likelihood of confusion in the true source of the products within the meaning of Ill. Rev. Stat. ch. 121½ sec. 312 (2). This statute provides that in order to prevail in an action such as this one, plaintiff need not prove actual confusion or misunderstanding of its product with those of the defendants. Consistent with Illinois law prior to enactment of the Uniform Act, *Lady Esther, Ltd.* v. *Esther Corset Shoppe, Inc.*, 317 Ill. App. 451 (1943), all that the plaintiff need prove is that in sales to members of the public there is likelihood of actual confusion or misunderstanding of its product with those of the defendants. From the evidence offered and received it clearly appears that defendants do not control the display, sale, and distribution of the product they market in the bottles and trade dress they copied from the plaintiff. In determining whether a likelihood of confusion exists, the article sold, its use, the kind of people who will buy it, the place of sale, should all be considered. *N. K. Fairbanks Co.* v. *Swift and Co.*, 64 Ill. App. 477 (1896). For these reasons a judgment shall be entered for the plaintiff. An appropriate decree may be tendered consistent with the record and granting relief in accordance with Ill. Rev. Stat. ch. 121½, sec. 313 (1965).

/s/ George N. Leighton
George N. Leighton
Judge, Circuit Court of Cook
County, Chancery Division

STATE OF ILLINOIS
COUNTY OF COOK—ss.

IN THE CIRCUIT COURT OF COOK COUNTY,
ILLINOIS, COUNTY DEPARTMENT,
CHANCERY DIVISION

CLAIROL INCORPORATED,
Plaintiff,
v.
ANDREA DUMON, INC., and
BERNARD MALITS,
Defendants.

In Chancery
No. 66 CH 2692

DECREE

This cause having come on to be heard upon the pleadings of the parties, the evidence heard in open Court, the exhibits received into evidence and the argument and briefs of the parties, and the Court being fully advised in the premises and having made certain findings more fully set forth in its memorandum filed July 10, 1969 which is attached hereto and incorporated by reference herein.

It Is Hereby Ordered, Adjudged And Decreed:

That defendants be permanently restrained, enjoined and prohibited from using the trade dress described in the said memorandum or any other trade dress which is colorably similar thereto or to the plaintiff's trade dress as described in said memorandum;

That defendants having been found to have wilfully engaged in a deceptive trade practice in that they wilfully simulated plaintiff's trade dress, that plaintiff's costs and attorneys fees be assessed against defendants and that a hearing be held to determine the amount of said costs and fees.

Enter:
Judge George N. Leighton
Circuit Court

Dated: July 31, 1969

STATE OF ILLINOIS
COUNTY OF COOK—ss.

IN THE CIRCUIT COURT OF COOK COUNTY, ILLINOIS, COUNTY DEPARTMENT, CHANCERY DIVISION

CLAIROL INCORPORATED, Plaintiff, v. ANDREA DUMON, INC., and BERNARD MALITS, Defendants.	In Chancery No. 66 CH 2692

SUPPLEMENTAL MEMORANDUM

(Filed June 25, 1970)

This is a post-decree proceeding. Defendants have filed a memorandum in opposition to award of attorney's fees. In addition, defendants have asked for and have been granted leave to file proposed additional or modifying findings of fact and conclusions of law to the court's Memorandum filed July 10, 1969.

The court has considered Memoranda filed by the parties, the proposed additional or modifying findings of fact and conclusions of law and the court has reviewed its Memorandum of July 10, 1969. It is the judgment of the court that defendant's opposition to award of attorney's fees to plaintiff should be overruled and the proposed additional or modifying findings of fact and conclusions of law rejected.

The order tendered for entry should provide that defendants' proposed additional or modifying findings of fact and conclusions of law be made part of the record.

This court's Memorandum of July 10, 1969 contains the grounds for rejecting the proposed additional or modifying findings of fact and conclusions of law and the overruling of defendants' opposition to award of attorney's fees.

A appropriate order may be tendered for entry consistent with this Supplemental Memorandum.

/s/ George N. Leighton
Judge, Circuit Court of Cook
County, Chancery Division

CLAIROL, INCORPORATED, *Plaintiff-Appellee,*

v.

ANDREA DUMON, INC., and Bernard Malits,
Defendants-Appellants.

No. 55514.

Appellate Court of Illinois,
First District, Second Division.

June 12, 1973.

Rehearing Denied Oct. 31, 1973.

DOWNING, Justice:

Plaintiff, Clairol, Inc., filed suit against defendants, Andrea Dumon, Inc., and its president, Bernard Malits, to enjoin distribution of Andrea Dumon "White Creamed Peroxide Developer," charging that the graphics, or "trade dress," on the defendants' container so closely imitated the graphics of plaintiff's "Pure White Creme Developer" that consumers would mistakenly purchase defendants' product in the belief it was plaintiff's.

The trial court permanently enjoined defendants from using plaintiff's trade dress, the court finding it to be colorably similar to plaintiff's. In addition, the court found defendants to have wilfully engaged in a deceptive trade practice, by wilfully simulating plaintiff's trade dress, and, accordingly, assessed against defendants the plaintiff's costs and attorneys' fees.

On appeal defendants contend the provisions of the Uniform Deceptive Trade Practices Act (Ill.Rev.Stat. 1967, ch. 121½, sec. 311 et seq.), not pleaded in the complaint, are not applicable to this suit; the trial court's injunctive order is contrary to the law and the evidence; and the trial court's assessment of costs and attorneys' fees is not supported by the findings and is manifestly against the weight of the evidence.

Plaintiff is a well-known manufacturer and marketer of cosmetic products. Its trade name is "Clairol," through which it has established a large and successful business, especially in the sale of products for coloring and treating human hair. In 1958, plaintiff, dissatisfied with the quality of existing hydrogen peroxide products then on the market (used as a preparation along with hair color dyes), decided to market its own peroxide product, calling it "Pure White Creme Developer."

The market for products of this type is divided into two parts: the beauty salon trade and the retail market for sale to the general public. At first, distribution of Clairol's peroxide product was limited to the salon trade, and the original sold in 16 ounce bottles; in 1960, Clairol introduced the product into the retail market for sale to the general public, packaging the retail product in four ounce bottles.

In both the professional salon trade and the retail field, plaintiff's hydrogen peroxide became the leading product of its kind, and, up to 1965, sales of both versions exceeded $15,000,000, representing over 45 million units. The trade dress for both Clairol products is virtually identical, the smaller four ounce bottle graphics being replicas of those employed on the larger 16 ounce item.

Clairol's 16 ounce version was bottled in cylindrical clear glass, seven and one-half inches high, topped with a white plastic cap. When filled, the white color of the bottle's contents provided an opaque background which emphasized the graphic elements printed on the outside of the bottle. Below the bottle's shoulder, Clairol placed a crown design, used on many of its products, and below the crown placed the word "Clairol," in block letters 3/16ths of an inch high. Below the name "Clairol" was a bar extending horizontally around 60 percent of the bottle's circumference, and beneath the bar were the words "Pure White Creme Developer," in block print 5/16ths of an inch in height. Descriptive words concerning plaintiff's product made up

part of the bottle's format. A color sequence of alternating mustard-gold and black was employed for each element of the design: the crown design in gold; the name "Clairol" in black; a peaked bar in gold, with the words "Pure White" and "Developer" in black; and the word "Creme" in gold. On the back side of the bottle appeared advertising copy and directions for use of the Clairol product.

From 1959 to 1961, defendant Bernard Malits was regional sales manager for plaintiff with responsibility for sales to the retail trade in Illinois and surrounding states. After leaving plaintiff's employ, Malits began business through a corporation, Malits Drug Company, a chain of ten retail stores in Chicago, selling drugs, cosmetics, and related items, which did business under the trade name "Golden Gate."

In 1965, Malits organized defendant Andrea Dumon, Inc., an Illinois corporation, with headquarters in Chicago, and commenced marketing its cosmetic products in retail stores in various parts of the country. Malits was, and is still, the president of Andrea Dumon, Inc.; moreover, he owns most of the corporation's stock.

Sometime late in 1965, defendant corporation initiated plans to market its own cream peroxide product. In determining the trade dress design to be used for the product, one Mr. Zavell, defendants' sales manager, procured a number of sample bottles then being used by other companies, including Clairol's bottle for its "Pure White Creme Developer." Zavell prepared a rough-drawn sketch of what was to be defendants' bottle and trade dress for its 16-ounce-capacity product, and submitted the sketch,[1] for precise completion, to an artist employed by the corporation.

With respect to the sketch, the court below, as part of its findings of fact, found:

---

[1] Zavell's sketch contained a "peaked" top bar similar to Clairol's; however, the "peaked" bar concept was later changed to a straight line, upon advice of defendants' counsel.

> A visual examination of the sketch discloses that it was copied directly from Clairol's 16 ounce bottle. The sketch closely follows the principal features of Clairol's trade dress, the sequence of design elements, the size, color and their special relationship(s) to each other. On the sketch are handwritten notations which shows instructions that the artist follow the spacing of the bars and other elements of plaintiff's 16 ounce bottle; so that the end product would correspond to the principal features of Clairol's package. Together with this sketch, the artist was given instructions as to the ultimate product he was to complete. • • • From the sketch, and after some changes, the artist completed his art work, and designed the bottle which is the subject of this suit.

Early in 1966, defendant corporation started marketing its peroxide developer in two bottle sizes (a pint size and a five and one-half fluid ounce size), incorporating the graphic design produced from the sketch prepared by Zavell, and from instructions given the artist by defendants.

Defendants' bottle, as produced from their instructions, was also of the stock glass kind, cylindrical, approximately 16 ounces in capacity, and of the same physical configuration as plaintiff's bottle. It differed in some detail at the shoulder, and the bottle's cap was, in height, about twice the size of plaintiff's. At the top of the graphics on the bottle face was an artistic drawing of the Golden Gate Bridge (in mustard-gold), a design reproduced in a size approximating that of Clairol's crown device. Below this design, in plain block letters, appeared the words "Andrea Dumon" (in black), in letters smaller thaan the Clairol name on plaintiff's 16 ounce bottle. Below "Andrea Dumon" was a bar (in mustard-gold) extending horizontally around 60 percent of the bottle's circumference, and beneath the bar were the words "White (in black) Creamed Peroxide (in mustard-gold) Developer (in

black)." And beneath those words, another mustard-gold bar. With the exception of details of little importance, defendants' bottles and trade dress were very similar to plaintiff's.

A visual comparison of the parties' 16 ounce bottles reveals a positive, striking likeness, and only in the respective locations and colors of the crown and bridge designs and the horizontal bars, but in the color schemes and sequences utilized, as well.

I.

The first question presented is whether the Uniform Deceptive Trade Practices Act is applicable here, as plaintiff's complaint did not plead the statute. The Act was passed in 1965, approved August 5, 1965 (Laws 1965, p. 2647), and became effective January 1, 1966; the statute deals with false, concealing, or deceptive trade identification, and false, confusing, or deceptive representations as to the source of origin of goods.

Although they cite no authority in support of their theory, defendants contend the trial court erroneously relied on the statute, as it had not been charged in the complaint or any subsequent pleading. The trial court held the complaint put defendants on adequate notice of the facts they were required to meet and that the facts, as pleaded, informed defendants of the applicable statutory law.

In *Chase* v. *Schultz* (2nd Dist. 1952) 348 Ill.App. 595, 109 N.E.2d 636, the court held a statute could be relied upon—even though no breach thereof was specifically pleaded—as long as the complaint set forth facts from which the applicable law could be clearly ascertained.

A review of the complaint indicates it sets forth a plain and concise statement of plaintiff's cause of action, thereby complying with Section 33 of the Civil Practice Act (Ill.Rev.Stat. 1967, ch. 110, sec. 33); it also clearly informs the defendants of acts, which, if established, would fall within the ambit of the Uniform Deceptive

Trade Practices Act. Defendants did not establish, nor can they now complain, that they were in any way misled. Further, the trial court had a right—if not a duty—to determine whether the evidence established any facts covered by the statute, and that is precisely what the court determined.

II.

In support of their contention that the decree entered below is contrary to the law and the evidence, defendants assert a number of arguments: plaintiff failed to prove its trade dress is distinctive or that it had acquired a secondary meaning; defendants' bottles are not likely to be confused with plaintiff's, and thus cause plaintiff any damage; and the injunctive order is against public policy. Therefore, defendants strenuously urge that we reverse the court below.

Defendants claim that packaged consumer goods are not protectible against simulation unless the package dress is distinctive and has acquired a secondary meaning, and further that plaintiff's package dress consists of functional, descriptive, and common packaging elements which cannot become distinctive or achieve secondary meaning.

The trial court found plaintiff's package dress to be distinctive and found that the dress has acquired secondary meaning, denoting the source from which the goods emanate.

The word "distinctive" means characteristic; having a distinct quality or position; a distinguishing mark or quality. (*In re Petition of Idaho State Federation of Labor* (AFL) (1954), 75 Idaho 367, 272 P.2d 707.) A "distinctive" mark, design, or trade dress is one which is a designation of source, rather than a characteristic of a product (*Wembley, Inc.* v. *Diplomat Tie Co.* (D.C.Md. 1963), 216 F.Supp. 565, 583), and the test of distinctiveness is whether a mark or design or a trade dress (as in this case) is such that it distinguishes one's goods from the goods of others. Section 2 of the Trademark Act of 1946, 15 U.S.C.A. § 1052.

Acquisition of a secondary meaning means no more than an association in the public mind between the trade dress of a product and the source of that product thus marketed. (*Sinko* v. *Snow-Craggs Corporation* (7th cir. 1939) 105 F.2d 450.) At trial, plaintiff produced proof that defendants copied Clairol's trade dress, and plaintiff asserts the uncontradicted proof that defendants did so, in itself, established that the product possessed a secondary meaning. Plaintiff's assertion is correct. Proof of copying, together with visual comparisons showing similarity in use and appearance between Andrea Dumon's and Clairol's products, is sufficient to establish that the trade dress employed by the defendants is likely to deceive the public and cause public confusion as to source. *Audio Fidelity, Inc.* v. *High Fidelity Recordings, Inc.* (9th cir. 1960) 283 F.2d 551, 558.

The simple answer to defendants' contentions is the record itself. The evidence supports the trial court's finding that defendants intended to, and did, imitate plaintiff's trade dress, and by so doing, they gave truth to plaintiff's claim that its trade dress had acquired a secondary meaning.

Adopting a different line of argument, defendants go on to urge that the type of products involved here are purchased by persons exercising care in selection—which minimizes the possibility of confusion—and that Andrea Dumon's bottles are not likely to be confused with Clairol's or cause plaintiff any damage. Plaintiff avers, on the other hand, that confusion is likely to occur, and that evidence of actual confusion need not be shown in order that it prevail in a suit such as this.

Consistent with Illinois law prior to the enactment of the Uniform Act (*Lady Esther, Ltd.* v. *Lady Esther Corset Shoppe, Inc.* (1943) 317 Ill.App. 451, 46 N.E.2d 195), plaintiff assumed the burden of showing, in the court below, a likelihood of actual confusion or misunderstanding in the public's mind regarding the source of Andrea Dumon's and Clairol's products.

Section 312 of the Act (Ill. Annot. Stat. 1967, ch. 121½, sec. 312), entitled "Acts constituting deceptive trade practice," reads, insofar as is pertinent:

> A person engages in a receptive trade practice when, in the course of his business, vocation or occupation, he:
>
> (2) causes likelihood of confusion or of misunderstanding as to the source, sponsorship, approval or certification of goods or services.
>
> In order to prevail in an action under the Act, a complainant need not prove competition between the parties or actual confusion or misunderstanding.

It is clear from the legislative notes accompanying Section 312(2) that the legislature intended, by the use of its phrase "likelihood of confusion or misunderstanding," to codify Illinois' common law tradition.

Moreover, regarding defendants' contention that the products involved are such that purchasers would exercise care in selection, thus minimizing the possibility of confusion, the United States Court of Appeals for the Second Circuit recently held that even with expensive merchandise (cameras)—where some substantial degree of care might be expected in the transaction—purchasers may yet be confused between similar identifications even where there is a plain disclosure as to source. *Omega Importing Corp.* v. *Petri-Kine Camera Co., Inc.* (2nd cir. 1971) 451 F.2d 1190.

The underpinnings of the policy behind decisions to find unfair competition in trade dress simulation cases, such as the one at hand, was summed up in *Harold F. Ritchie, Inc.* v. *Chesebrough-Pond's, Inc.,* (2nd cir. 1960) 281 F.2d 755, 758:

> (I)t is permissible in the American competitive economy for the second comer to endeavor to capture as much of the first comer's market as he can. He must do this, however, by giving his product a name and dress descriptive and fanciful in its own right and

selling it on its own merit, not by confusing the public into mistakenly purchasing his product for his competitor's. The second comer must create a reputation of its own and not trade on the goodwill of another product already established at considerable cost and risk.

With respect to the issue of likelihood of confusion, defendants' argument that plaintiff will not be damaged because of a lack of likelihood of confusion is wholly unsupported, as likelihood was found by the trial court and plaintiff certainly would stand to lose a great deal of business from the resultant confusion.

Shifting to another, different rationale, defendants argue that the law of unfair competition is no longer viable in light of the Supreme Court's decisions in *Sears, Roebuck & Co.* v. *Stiffel Co.*, (1964) 376 U.S. 225, 84 S.Ct. 784, 11 L.Ed.2d 661, and *Compco Corp.* v. *Day-Brite Lighting, Inc.* (1964) 376 U.S. 234, 84 S.Ct. 779, 11 L.Ed.2d 669, while plaintiff contends those decisions have nothing whatever to do with the case at bar, as both dealt with the legality of so-called "knock-offs," i. e., the copying and imitation of another's product, devoid of any question concerning simulation of packaging or trademarks.

In *Compco*, the plaintiff had developed a commercial fluorescent lighting fixture with a cross-rib reflector intended to reduce chipping of the reflective coating and add strength, and the defendant, by incorporating plaintiff's design into its lighting fixture, was marketing obvious copies of the plaintiff's product. In *Sears*, the defendant sold a "pole lamp" copied from the plaintiff's.

The Supreme Court held in both cases that Article I, Section 8, Clause 8 of the United States Constitution vests the power in Congress to grant patents; that the configuration of a device can be protected by a design patent; that the subject matter copied in the cases before it was within the bounds of what might be covered by a design patent, and, that, consequently, it would be uncon-

stitutional interference for state common law to intrude into an area exclusively within the congressional province.

In *Sears,* 376 U.S. at page 232, 84 S.Ct. at page 789, the Supreme Court made clear that its holding pertained only to the copying of products and not to the copying of trademarks or packaging, which state law might validly protect from unfair simulation:

> (D)oubtless a State may, in appropriate circumstances, require that goods whether patented or unpatented, be labeled or that other precautionary steps be taken to prevent customers from being misled as to source, just as it may protect businesses in the use of their trademarks, labels, or *distinctive dress in the packaging of goods* so as to prevent others, by imitating such markings, from misleading purchasers as to the source of the goods. But because of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying. (Emphasis added.)

Thus, the trial court's ruling that defendants' interpretation of these cases was mistaken is eminently correct. *Sears* and *Compco* involved the copying of articles or products, and not the simulation of trade dress.

Defendants rely heavily upon *Spangler Candy Company* v. *Crystal Pure Candy Company,* (D.C.N.D.Ill. 1964), 235 F.Supp. 18, aff'd. (7th Cir. 1965) 353 F.2d 641, arguing that the holding there precludes a decision against them here. We believe, however, that their reliance is misplaced.

In *Spangler,* plaintiff, a manufacturer of lollipops, had alleged trademark infringement and unfair competition by defendant-manufacturer, which had marketed lollipops in packages admittedly imitating plaintiff's. The District Court dismissed plaintiff's complaint and defendant's counterclaim, and both parties appealed. The Court of Appeals affirmed, holding that the evidence supported

findings that plaintiff had failed to show, first, that defendant was "palming off," and, second, that plaintiff's lollipop package format had acquired a sufficient "secondary meaning."

First of all, we think it significant that the Uniform Deceptive Trade Practices Act was enacted subsequent to both *Spangler* decisions. Secondly, the key sections of the Act, some of which are particularly relevant to the case at bar, are no more than codifications of the modern, broad view of unfair competition exemplified by this court's analysis of the subject prior to the Act's adoption (*Lady Esther, Ltd.* v. *Lady Esther Corset Shoppe, Inc.* (1943) 317 Ill.App. 451, 46 N.E.2d 165), the prefatory notes to the Act (Ill.Annot. Stat. 1967, ch. 121½, sec. 311 et seq.) say as much:

> In the area commonly referred to as 'passing off' or the deception of the consumer as to the source of a product, the Uniform Deceptive Trade Practices Act (subsections (1), (2), (3) and (4) of Section 312 of the Illinois Act) merely codifies and sets forth in logical fashion the liberal principles which have become associated with the tort of unfair competition in recent years, both in Illinois and other states.

Armed with a knowledge of Illinois' common law tradition in the area of unfair competition, and with a history of the legislative intent underlying the Act's drafting and adoption, it is our view that the Act clearly seeks to provide a remedy for those subjected to the type of activity the defendants have engaged in here.

Defendants also offer several other cases to support their theories that they have not unfairly competed with plaintiff; that the public would not be confused or misled; that their package does not simulate plaintiff's; that public policy requires a reversal of the trial court's findings and decree; and so forth. Upon careful inspection of the authorities relied upon, however, all are distinguishable from the matter before us, either on the law or the facts.

The trial court, having listened to extensive testimony and having viewed the actual containers and other exhibits, issued detailed findings and conclusions of law. We have carefully reviewed the entire record and examined the actual containers and trade dress. We find there is substantial evidence to support the trial court's findings and the injunctive order issued.

III.

Finally, defendants claim strongly that the trial court's award of $20,616.43 attorneys' fees and costs to the plaintiff was erroneous for two reasons: (a) the court below failed to find that defendants were wilfully engaged in a deceptive trade practice, and (b) that bestowing the award was an abuse of discretion and, in addition, punitive.

The trial court acted under Section 313 of the Uniform Deceptive Trade Practices Act in assessing costs and attorneys' fees; the Section provides, in part:

> Costs or attorneys' fees or both may be assessed against a defendant only if the court finds that he has wilfully engaged in a deceptive trade practice.

Exercising its power under Section 313, the trial court, in its decree, held:

> That defendants having been found to have wilfully engaged in a deceptive trade practice in that they wilfully simulated plaintiff's trade dress, that plaintiff's costs and attorneys' fees be assessed against said defendants * * *.

The word "find" means to arrive at, as a conclusion, or to determine and declare (*State ex rel. Iowa National Mutual Insurance Co.* v. *Florida Industrial Commission* (Fla.1963) 151 So.2d 636, 639), and that is the sense and meaning of "finds" in Section 313. Defendants would have us believe "finds" in the context of the Section calls for a recitation of findings of fact based upon the evidence of record, the recitation being the responsibility of the trial court; but defendants' semantical interpretation is

not applicable. *School District No. 7 of Wallowa County* v. *Weissenfluh* (Or.1963), 236 Or. 165, 387 P.2d 567, 569. We fail to discover any error in the actions of the trial court with respect to the award of attorneys' fees and costs. Such action was not against the manifest weight of the evidence.

The judgment of the circuit court of Cook County is accordingly affirmed.

Judgment affirmed.

STAMOS, P. J., and HAYES, J., concur.

(Letterhead Of)

CLERK OF THE SUPREME COURT

January 30, 1974

Mr. David Chaimovitz
Attorney at Law
33 North LaSalle St.
Chicago, Ill. 60602

No. 46328—Clairol, Incorporated, respondent, vs. Andrea Dumon, Inc., et al., petitioners. Leave to appeal, Appellate Court, First District.

You are hereby notified that the Supreme Court today denied the petition for leave to appeal in the above entitled cause.

Very truly yours,
/s/ Justin Taft
Clerk of the Supreme Court

LIBRARY
SUPREME COURT, U. S.

Supreme Court, U. S.
FILED
JUN 17 1974
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1973

No. 73-1624

ANDREA DUMON, INC. and BERNARD MALITS,
Petitioners,

vs.

CLAIROL, INCORPORATED,
Respondent.

OPPOSITION TO PETITIONERS' WRIT FOR CERTIORARI

ALFRED T. LEE
WEIL, LEE & BERGIN
60 East 42nd Street
New York, New York 10017
Attorney for Respondent

TABLE OF CONTENTS

PAGE

Statement of the Case 1

REASONS FOR DENYING THE WRIT:

I—The prior rulings of this Court do not sustain the interpretation thereof upon which petitioners rely. Indeed those cases and other subsequently decided directly controvert Petitioiners' arguments 3

II—The adequacy of the proofs found sufficient by the Courts below is not for this Court to review. Neither is there any basis for review of the pleading rules of the Illinois Courts or the remedies they provide for fraud in commercial affairs 6

CONCLUSION 8

Table of Cases

Audio Fidelity, Inc. v. *High Fidelity Recordings, Inc.*, 283 F. 2d 551 (9th Cir. 1960) 6

Clase v. *Schultz*, 348 Ill. App. 595, 109 N.E. 2d 636 (1953) 7

Compco Corp. v. *Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964) 3

Fleischmann Distilling Corp. v. *Maier Brewing Co.*, 314 F. 2d 149 (9th Cir. 1963) 6

Goldstein v. *California*, 412 U.S. 546 (1973) 5

Hall v. *Cole*, 412 U.S. 1 (1973) 7

Kewanee Oil Co. v. *Bicron Corp.*, U.S. .. 5

Mills v. *Electric Auto-Lite Co.*, 396 U.S. 375 (1970) 7

PAGE

New England Awl Co. v. *Marlborough Awl Co.*, 46 N.E. 386, 387 (1897) 6

Sears Roebuck and Co. v. *Stiffel Co.*, 376 U.S. 225 (1964) 3

United Drug Co. v. *Theodore Rectanus Co.*, 248 U.S. 90 (1918) 4

Miscellaneous

Callman, The Laws of Unfair Competition, Trademarks and Monopolies, 3rd Ed. (1967) 5

Developments in the Law—Competitive Torts, 77 Harv. L. Rev. 888, 911-918 (1964) 6

Ill. Rev. Stat. 1967, ch. 110, Sec. 33 7

Lanham Trademark Act of 1946, 15 USC 1051 *et seq.* 4

Nims, Trademarks and Unfair Competition, 4th Ed. 5

Patent Law, 35 USC 171 3

State Trademark Registration Manual, United States Trademark Association, Rev. Ed. 1966 5

Trademark Act of 1905, 15 USC §§ 81-134 4

United States Constitution, Article I, § 8, cl. 8 4

IN THE

Supreme Court of the United States

October Term, 1973

No. 73-1624

ANDREA DUMON, INC. and BERNARD MALITS,

Petitioners,

VS.

CLAIROL, INCORPORATED,

Respondent.

OPPOSITION TO PETITIONERS' WRIT FOR CERTIORARI

Statement of the Case

With the exceptions noted below, Respondent will accept Petitioners' statement of the case for purposes of the within Petition.

1. As stated by Petitioners, they sold only $175 of their product in the offending trade dress, having discontinued the sale thereof soon after the suit was filed (apparently to avoid substantial liability for damages and an accounting of profits should they have continued those practices *pendente lite*). However, they gave notice of their intention to resume use of that trade dress unless Respondent procured an injunction, thus forcing the latter to the expense of a trial which resulted in a judgment that, in part, requires Petitioners to reimburse Respondent for a portion of such expense.

2. The evidence of "secondary meaning" was based upon more than an inference drawn from proof of intentional copying by Petitioners of Respondent's trade dress. There was also evidence of the considerable effort to which Respondent went in designing a unique and appealing package appearance; the distinctiveness of that appearance in contrast to the packaging of others, and the substantial exposure to the public of Respondent's product through its extensive display and sale.

3. Respondent did not contend for the exclusive right to the use of two horizontal bars and the color gold. It sought, and obtained, a judgment to preclude Petitioners' use of a colorable imitation of Respondent's trade dress, not an injunction directed to specific features such as bars and colors (Petitioner's Appendix, p. 12a). Petitioners opted to change their trade dress by removing the two bars and printing all of the graphics in black, to which Respondent had no objection. Petitioners could have made a myriad of other changes—while retaining the two bars and the color gold—which would avoid confusing similarity between their package's appearance and Respondent's.

4. There was testimony that, in some stores, consumers asked for Respondent's product by using the name "Clairol". However, there was also testimony that in other stores—including those owned by the individual petitioners—the products were displayed for self selection where trade dress would serve as the means of identification.

5. Petitioners "original label sketch" did not merely show "similarities" to Respondent's trade dress. It clearly was an overlay of the latter, with the handwritten word "Clairol" as a direction to the commercial artist concerning what he was to copy.

REASONS FOR DENYING THE WRIT

I.

The prior rulings of this Court do not sustain the interpretation thereof upon which Petitioners rely. Indeed those cases and other subsequently decided directly controvert Petitioners' arguments.

The essential thrust of the Petitioners' position herein is that the decision of the Illinois State Court below conflicts with this Court's rulings in *Sears, Roebuck and Co.* v. *Stiffel Co.*, 376 U.S. 225 (1964) and *Compco Corp.* v. *Day-Brite Lighting*, 376 U.S. 234 (1964). Petitioner's reliance upon those cases, however, rests upon a serious misreading of their facts.

Both involved an attempt to protect, under the doctrine of unfair competition, the physical configurations of products, such configurations being within the scope of the design patent laws, 35 USC 171. In fact, in each of those cases a design patent had been sought and obtained on the configuration—patents found invalid for lack of invention.

This case does not involve the configuration of a product but rather is concerned only with trade dress. Petitioners—new entrants in the field—were found to have deliberately copied the trade dress of the leading product in the category. They purposefully set out to offer their product garbed in the *tout ensemble* of their premier competitor.

In *Sears* and *Compco, supra,* this Court held that product configurations which fall within the scope of the design patent law may not be protected under state law concepts of unfair competition. The Court was careful, however, to distinguish between the copying of a product and the simulation of its distinctive package appearance. The State Court below specifically quoted the language of *Sears* wherein that distinction was drawn.

> "'(D)oubtless a State may, in appropriate circumstances, require that goods whether patented or unpatented, be labeled or that other precautionary steps be taken to prevent customers from being misled as to source, just as it may protect businesses in the use of their trademarks, labels, or *distinctive dress in the packaging of goods* so as to prevent others, by misleading purchasers as to the source of the goods. But because of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying.' (Emphasis added)."
>
> Petitioner's Appendix, p. 23a.

The distinction is soundly based. Article I, § 8, cl. 8 of the Constitution vests Congress with the power to provide legal protection for the writings and discoveries of authors and inventors. *Sears* and *Compco* held that the Supremacy Clause precludes the states from protecting that which is within the scope of such federal power, but which fails to meet the standards established by Congress for protection thereunder.

Insofar as commercial identifications such as trademarks are concerned, however, Congressional action finds its authority in the Commerce Clause, that being the Constitutional predicate for the Lanham Trademark Act of 1946, 15 USC 1051 *et seq.*, *Fairway Foods* v. *Fairway Markets, Inc.*, 227 F. 2d 193, 196-7 (9th Cir. 1955) and its predecessor Trademark Act of 1905, 15 USC §§ 81-134, *United Drug Co.* v. *Theodore Rectanus Co.*, 248 U.S. 90 (1918).

It has not been responsibly suggested that enactment of the Lanham Act or its predecessor, 15 USC §§ 81-134, ousted the individual states from the prevention of

fraudulent commercial practices involving the deceptive use of trademarks, trade names and trade dress where such state action does not conflict with or override the federal scheme. Virtually every State in the Union has enacted legislation protecting such commercial indicia * and there is a vast body of state court decisions enforcing common law principles of business rectitude.** The side-by-side existence of both federal and state involvement in such protection for almost seventy years argues strongly for the propriety thereof, *Kewanee Oil Co.* v. *Bicron Corp.*,

U.S. , decided May 13, 1974.

The fatal flaw in Petitioners' argument is the absence of any contention that the State law relied upon below "clashes with the objectives of the federal patent laws" or any other federal statute, *Sears, Roebuck, supra* at 231.

Since *Sears, Roebuck* and *Compco*, this Court has carefully traced the bounds thereof insofar as they impact upon state action in related contexts. In *Goldstein* v. *California*, 412 U.S. 546 (1973) it was held that despite the refusal by Congress to protect sound recordings (pre-1972) from unauthorized copying, the states are not barred from doing so. More recently, it was held that the federal patent laws do not prevent the states from protecting trade secrets, even those which could have been, but were not, protected by federal patent, *Kewanee Oil Co.* v. *Bicron Corp., supra.*

---

* See *State Trademark Registration Manual, United States Trademark Association*, Rev. Ed., 1966.

** See generally, *Nims, Trademarks and Unfair Competition*, 4th Ed. (1947) and *Callman, The Laws of Unfair Competition, Trademarks and Monopolies*, 3rd Ed. (1967).

II.

The adequacy of the proofs found sufficient by the Courts below is not for this Court to review. Neither is there any basis for review of the pleading rules of the Illinois Courts or the remedies they provide for fraud in commercial affairs.

A.

It surely is not an issue of constitutional dimension that the Courts below relied upon a rational—indeed, a compelling—inference in holding Respondent's trade dress to be worthy of protection. Where one deliberately sets out to imitate the trade dress of the leading product in the field, it may safely be assumed that he, himself, recognizes the commercial value of that which he simulates, *Audio Fidelity, Inc.* v. *High Fidelity Recordings, Inc.*, 283 F. 2d 551 (9th Cir. 1960); *Fleischmann Distilling Corp.* v. *Maier Brewing Co.*, 314 F. 2d 149 (9th Cir. 1963), *Note, Developments in the Law—Competitive Torts*, 77 Harv. L. Rev. 888, 911-918 (1964).

Moreover, the Courts below also relied upon the extensive use of Respondent's trade dress in holding it proctectible. As long ago as 1897, Justice Holmes thought an inference of legal protectibility to be a proper one from such evidence and sufficient to dispense with the necessity for other proofs to establish the point.

> "The report states that it did not appear whether or not any purchaser of awls had learned to recognize the plaintiff's awls by the appearance of the packages. This cannot mean more than that there was no direct testimony to that effect. But the fact that the plaintiff had used the combination since 1885, and largely since 1893, is enough to raise a presumption in its favor."
>
> *New England Awl Co.* v. *Marlborough Awl Co.*, 46 N.E. 386, 387 (1897).

B.

Petitioners make the rather novel argument that, inasmuch as the complaint did not explicitly forwarn them of the substantive law upon which it was based, they were deprived of due process.

Illinois rules of pleading do not differ greatly from those of the federal courts. Illinois requires only that sufficient facts be alleged from which it can be ascertained what law is involved, *Clase* v. *Schultz*, 348 Ill. App. 595, 109 N.E. 2d 636 (1953). In close parallel to Rule 8 of the Federal Rules of Civil Procedure which requires no more than a "short and plain statement of the claim", Illinois requires only "a plain and concise statement" of the claim, Ill. Rev. Stat. 1967, ch. 110, Sec. 33.

Pleadings are not a constitutionally mandatory vehicle for the citation of statutes and the recitation of legal theories. Other procedures are available to ascertain a plaintiff's substantive reliance.

In any event, no showing is attempted here or was made below that Petitioners were in any way prejudiced by that of which they now complain.

C.

In *Fleischmann Distilling Corp.* v. *Maier Brewing Co.*, 386 U.S. 714 (1967) this Court acknowledged the propriety of awarding attorney's fees to a prevailing plaintiff when allowed by statute. The antitrust laws, to take but one example from federal statutes, exemplify both the deterrant and remedial value of such awards. Indeed, in the face of *Fleischmann*, this Court has since approved awards of attorney's fees despite the lack of a specific statutory authorization, *Mills* v. *Electric Auto-Lite Co.*, 396 U.S. 375, 389-97 (1970) (§ 14a of the 1934 Securities Act); *Hall* v. *Cole*, 412 U.S. 1, 4-15 (1973) (§ 102 of the Labor-Management Reporting and Disclosure Act).

Regarding Petitioner's due process argument, it should be sufficient to say that the complaint in this action expressly requested that attorney's fees be awarded. Petitioners, therefore, were on notice of the liability they faced and which was authorized by the state statute which they were found to have violated.

CONCLUSION

The decision below was eminently correct in holding that Petitioners had engaged in unfair competition with Respondent. No question of a constitutional nature has been made to appear herein.

WHEREFORE, Respondent prays that this Court refuse to issue the Writ sought.

Respectfully submitted,

ALFRED T. LEE
WEIL, LEE & BERGIN
60 East 42nd Street
New York, New York 10017
Attorney for Respondent

LIBRARY
SUPREME COURT, U. S.

Supreme Court, U. S.
FILED
NOV 8 1974
MICHAEL RODAK, JR., CLE

IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-1624

ANDREA DUMON, INC. and BERNARD MALTZ,

Petitioners,

vs.

CLAIROL, INCORPORATED,

Respondent.

PETITION FOR REHEARING OF DENIAL OF PETITION FOR WRIT OF CERTIORARI TO THE APPELLATE COURT OF ILLINOIS, FIRST DISTRICT

ESTHER O. KEGAN
GLENN E. KLEPAC
KEGAN, KEGAN & BERKMAN
79 W. Monroe Street, Suite 1239
Chicago, Illinois 60603

DAVID CHAIMOVITZ
33 N. LaSalle Street, Suite 2011
Chicago, Illinois 60602

Attorneys for Petitioners

Midwest Law Printing Co., Chicago 60601, Financial 6-6366

In The

Supreme Court of the United States

October Term, 1973

No. 73-1624

ANDREA DUMON, INC. and BERNARD MALITS,

Petitioners,

vs.

CLAIROL, INCORPORATED,

Respondent.

PETITION FOR REHEARING OF DENIAL OF PETITION FOR WRIT OF CERTIORARI TO THE APPELLATE COURT OF ILLINOIS, FIRST DISTRICT

To The Justices Of The Supreme Court Of The United States:

Petitioners, Andrea Dumon, Inc. and Bernard Malits, respectfully pray for a rehearing of the order denying their petition for a writ of certiorari to review the judgment of the Appellate Court of Illinois, First District,

Clairol, Incorporated v. *Andrea Dumon, Inc.*, 14 Ill. App.3d 641, 303 N.E. 2d 177, 179 USPQ 119 (1973). Said decision so interpreted the common law and statutory law of unfair competition as to restrict competition and deny defendants due process of law (The Illinois Uniform Deceptive Trade Practices Act, Ill. Rev. Stat. 1973 Ch. 121½, Sec. 311).

Within the past three weeks a decision of the Second District of the Illinois Appellate Court (*Filter Dynamics International, Inc.* v. *Astron Battery, Inc.*, 183 USPQ 102 (1974); leave to appeal to the Illinois Supreme Court has been denied) was published*, which interpreted the applicability of said Uniform Deceptive Trade Practices Act diametrically opposite, in many important respects, to the decision of the court here below. This Second District decision in conjunction with the decision of the court below of the First District has intensified the muddled state of the law of unfair competition applicable to uncopyrighted package graphics. We submit that this conflicting decision constitutes substantial intervening circumstances warranting this petition for rehearing under Rule 58(2) of the Rules of the United States Supreme Court.

The petitioners and the business community are entitled to guidelines from this Honorable Court pertaining to the scope of monopoly afforded by the courts to uncopyrighted, unpatented, non-trademark package graphics of consumer goods. The lacuna left by this Honorable Court in 1964 in the cases of *Sears* (*Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 224) and *Compco* (*Compco Corp.* v.

---

* This decision was published in the Patent Trademark and Copyright Weekly Reports dated October 14, 1974; the instant petition for a writ of certiorari was denied on October 15, 1974.

Daybrite Lighting, Inc., 376 U.S. 234) with respect to competitive use of the same package graphics not monopolized by copyright should now be filled in by specific guidelines by this Court.

The *Clairol* v. *Andrea Dumon* decision below and this recent *Filter Dynamics* decision, *supra*, conflict in two vital areas pertaining to the law of unfair competition, namely, (1) does copying of features of packaging constitute *per se* unfair competition, and (2) is testimony of plaintiff's own witnesses alone sufficient to prove secondary meaning in said graphics, without any evidence of conscious consumer identification of package graphics to producer of product.

(1) The Per Se Rule that Copying Gives Monopoly Rights on the Graphics Copied.

In the *Clairol* decision below, the Court held that proof that defendants copied the graphics of plaintiff's bottle "established" that said bottle graphics had acquired "secondary meaning", stating that defendants did

> "imitate plaintiff's trade dress, and by so doing, they gave truth to plaintiff's claim that its trade dress had acquired secondary meaning." (App. p. 20a)

This affirmed the trial court's conclusion that "uncontradicted proof that the defendants copied the design of plaintiff's bottles and trade dress established their possession of a secondary meaning" (Judge Leighton's opinion of July 10, 1969, App. p. 10a).

Exactly opposite is the decision in the recent *Filter Dynamics* case in which the court held (183 USPQ at p. 109):

> "assuming, as the plaintiffs claim, that defendants did copy the form of plaintiffs' Vu-Pak container, plain-

> tiffs would still not be excused from *establishing by direct evidence* that a secondary meaning had attached to the form alone of their Vu-Pak . . . copying features of plaintiffs' packaging which are not primary determinants of consumer source association of the product *cannot presumptively establish* either likelihood of confusion or *secondary meaning.*" (Italics supplied.)

Thus the *Clairol* decision makes copying *per se* unfair competition; the *Filter Dynamics* decision refuses to do so. It is submitted that rules of fair competition and non-statutory monopoly should be clarified by this Court by reviewing the *Clairol* decision below.

(2) Testimony by Plaintiff's Own Corporate Executives Alone Should Not Be Proof of Secondary Meaning of Package Dress.

The court in the *Clairol* decision below (op. cit.) supported the trial court's conclusion that plaintiff proved secondary meaning as to plaintiff's bottle notwithstanding the court made the following findings of fact part of the record:*

> No. 5. "Plaintiff did not introduce any testimony except that of its Vice President in charge of marketing."
>
> "Plaintiff did not introduce any evidence of consumer confusion or consumer reaction to plaintiff's trade dress."

---

* Judge G. N. Leighton's Supplemental Memorandum, No. 66 Ch. 2692, dated June 25, 1970, reproduced in appendix p. 13a, with respect to "Additional Findings of Fact and Conclusions of Law Proposed by Defendants", filed March 3, 1970.

The recent *Filter Dynamics* case holds, on the contrary, that

> "There was testimony by plaintiffs' witnesses that consumers might be confused as to the source or origin of batteries sold in defendants' prototype box. The testimony was not based on actual instances of confusion or consumer surveys, but was the opinions of the witnesses themselves as advertising and marketing experts. The credibility or weight of their testimony in establishing the essential element of likelihood of confusion is subject to discount because they hold important positions with the plaintiffs." (183 USPQ at p. 110)

CONCLUSION

Thirteen states* have adopted the model state law known as the Uniform Deceptive Trade Practices Act. The *Clairol* decision below, in conflict with a decision of a different district in Illinois as well as with the decision in *Mr. Gasket Co.* v. *Travis,* 299 N.E. 2d 906 (Ohio Ct. App. 1973), creates confusion and uncertainty as to the scope of protectability of uncopyrighted package graphics under these states' laws of unfair competition.

---

* These 13 states are Colorado, Connecticut, Delaware, Florida, Georgia, Hawaii, Idaho, Illinois, Maine, Nebraska, New Mexico, Ohio and Oklahoma.

Rehearing on the instant petition for a writ of certiorari is respectfully requested.

Respectfully submitted,

ESTHER O. KEGAN
GLENN E. KLEPAC
KEGAN, KEGAN & BERKMAN
79 W. Monroe Street, Suite 1320
Chicago, Illinois 60603

DAVID CHAIMOVITZ
33 N. LaSalle Street, Suite 2021
Chicago, Illinois 60602

Attorneys for Petitioners